

### SECTION III—REMARKS

This Amendment is submitted in response to the final Office Action mailed November 5, 2003. No claims are amended herein, and claims 1, 3-5, 7, 8, 19 and 21-26 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the following remarks.

#### Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 19, and 21-24 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,704,650 to Laurash et al (“Laurash”), U.S. Patent No. 6,536,660 to Blankenship et al (“Blankenship”) and one or both of U.S. Patent Nos. 5,783,810 and 5,793,030 to Kelly, Jr. (collectively “Kelly”). The Examiner also rejected claims 7, 8, 25 and 26 under § 103(a) as obvious in view of, and therefore unpatentable over, Laurash, Kelly and Blankenship further in view of U.S. Patent No. 6,348,685 to Brower et al (“Brower”).

The Examiner’s reasoning in making these rejection is identical to the reasoning used in the previous non-final Office Action. Specifically, the Examiner alleges that Laurash discloses first and second labels with a printed identifier, but concedes that it does not disclose a component container, an identifier that identifies a component inside the component container, or an identifier electronically stored in the component and read therefrom for printing labels. Similarly, the Examiner alleges that Kelly discloses a component container having components and a device inside the component container, wherein a label is removably affixed to the component container and has an identifier (*i.e.*, a bar code) that identifies the component inside the container, but the Examiner concedes that Kelly also does not disclose an identifier electronically stored in the component and read therefrom for printing the labels. Finally, the Examiner alleges that Blankenship discloses an identifier that can be electronically stored on a component (in this case a wire), read and placed as a bar code on an adhesive label, wherein the adhesive label is placed on any desirable surface, such as a reel or barrel for holding wire. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laurash and Kelly to include an identifier electronically stored and encoded on a label as taught by Blankenship for the purpose of providing the end user with tracking information pertaining to the component.

Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 1 recites, among other things, an article of manufacture comprising a component container and "first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels." The Examiner concedes that Laurash and Kelly do not disclose an identifier electronically stored in the component and read therefrom for printing on labels, but asserts that Blankenship discloses this limitation.

Applicant respectfully disagrees with the Examiner's characterization of Blankenship. Blankenship discloses that information about a welding wire can be stored in the wire itself, and that the same information stored in the wire can also be encoded in a bar code and printed on a label. The wire, however, is never the source of the information used to encode and print the bar code: once the information is stored on the wire, it is never read from the wire for use in the encoding or printing of a label. The passage cited by the Examiner (col. 3, lines 3-33) discloses only that the information can be read from the wire after it is removed from the spool and when it is used for its intended purpose, such as in a welding machine, but does not disclose, teach or suggest that the wire itself is the source of the information printed on the label. Laurash, Kelly and Blankenship therefore cannot disclose, teach or suggest, alone or in combination, an article of manufacturing including "first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels." Applicant submits that claim 1 is therefore in condition for allowance and respectfully requests withdrawal of the rejection.

Regarding claims 3-5, 7 and 8, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance.

Applicant therefore respectfully submits that claims 3-5, 7 and 8 are allowable by virtue of their dependence on allowable claim 1 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 19 recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label, and "first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon an identifier that uniquely identifies a component inside a component container to which the base label can be attached, the identifier being electronically stored in the component and read therefrom for printing on the identification labels." As discussed above in connection with claim 1, Laurash, Blankenship and Kelly do not disclose, teach or suggest an article of manufacture having the recited combination of features. Applicant submits that these references cannot render the claimed invention obvious, and therefore respectfully requests withdrawal of the rejection.

Regarding claims 20-26, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 19 is in condition for allowance. Applicant therefore respectfully submits that claims 20-26 are allowable by virtue of their dependence on allowable claim 19 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

#### Conclusion

Given the above remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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